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17 JAN 2008

In re Application of: :
Sasaki et al. :
Application No.: 09/516,176 :
PCT Appln. No.: PCT/JP98/03918 :
Int. Filing Date: 02 September 1998 :
Priority Date: 02 September 1997 : DECISION
Attorney Docket No.: PM 266297 :
For: Fine Hollow Powder, Thin Flaky Titanium Oxide :
Powder Obtained By Pulverization Of The Fine Hollow :
Powder And Processes For Producing The Same :

This case is before the Office of PCT Legal Administration for treatment of issues arising under 35 U.S.C. 371.

BACKGROUND

International application PCT/JP98/03918 was filed on 02 September 1998, claimed an earliest priority date of 02 September 1997, and designated the United States. The International Bureau transmitted a copy of the published international application to the USPTO on 11 March 1999, and a Demand was filed prior to the elapse of 19 months from the priority date. The 30 month period for payment of the basic national fee in the U.S. ended as of midnight on 02 March 2000. On 01 March 2000, applicants filed the correspondence and fees which became the instant application, which was processed under 35 U.S.C. 111(a).

DISCUSSION

The USPTO has adopted a bright-line test for determining whether application papers will be processed under 35 U.S.C. 371 or alternatively under 35 U.S.C. 111(a). Under this standard, any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.

Alternatively, one of the following indications may be used:

- 1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or
- 2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application.

Inspection of the correspondence filed on 01 March 2000 reveals that the executed declaration of the inventors was directed to PCT/JP98/03918, the Transmittal Letter was entitled as being "For Filing National Phase Of PCT Application Under 35 U.S.C. 371 And 37 CFR 1.494 or 1.495," and the cover page of the specification indicated that "This is a PCT National Phase Application." The Transmittal Letter also indicated that the basic national fee was being paid. All these indicia in the submission of 01 March 2000 constituted instructions that processing under 35 U.S.C. 371 was desired, and no contrary instructions requesting processing under 35 U.S.C. 111(a) appear to have been present on 01 March 2000. Therefore, the submission properly should have been processed under 35 U.S.C. 371.

Inspection of the declaration filed on 01 March 2000 reveals that it nominates "Yuichi MICHIE" in place of "MITIGAMI, Youichi" who was named in the published international application. As this represents more than a mere typographical error or phonetic misspelling, a proper petition (and fee) under 37 CFR 1.182 is required. See MPEP 605.04(b). Alternatively, if a change of inventorship is sought, a submission under 37 CFR 1.497(d) would be appropriate.

DECISION

This international application is being forwarded to the Office of Patent Application Processing for processing under 35 U.S.C. 371, including the correction of the electronic records of the USPTO to show this application as the U.S. national stage of PCT/JP98/03918 and including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration compliant with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(h).



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